

longitudinal movement of said valve body along said post, wherein said sleeve includes guide members for defining a longitudinal channel within said sleeve for said stop member, said stop member being seated within said channel to both limit the longitudinal movement and restrict rotational movement of said valve body within said sleeve, and wherein said central post includes support elements disposed between said post and said valve body proximate to said channel to prevent the axial removal of said deformable valve body from said sleeve while said stop member is disposed within said channel.

Kindly cancel claims 6, 8, and withdraw claims 10-32.

Remarks

The present amendment is in response to the office action dated May 17, 2000 in the above-identified patent application. Filed concurrently herewith is a request for a two-month extension of time so that the present amendment is due October 17, 2000.

In the office action, claims 1-33 were pending, with claims 10-32 withdrawn from consideration due to a restriction requirement. Applicant affirms the election of group I, consisting of claims 1-9, with traverse, the withdrawal of non-elected claims 10-32, and the addition of dependent claim 33 pursuant to a separate response submitted on March 15, 2000. The Examiner has also identified various informal errors in figure 13 for the leader line on element 28 and in figure 12 for the leader line on element 82, both needing correction and a copy of the to Figures 12 and 13 correction in red is also included with this amendment. In the specification the Examiner identified a correction that is required on page 9, line 7 for a typographical error. The drawing corrections are submitted under 37 C.F.R. §1.121 (a)(3) for figures 12 and 13 with a new corrected drawing sheet and a sheet with the proposed changes in red in a separate paper. The

specification correction is submitted with this amendment. None of these changes incorporates any new matter into the present application.

Turning then to the substantive rejections over the art, claims 1-3, 7, 9, and 33 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,201,013 to Porter et al. The Examiner also rejected claims 4 and 5 under 35 U.S.C. §103(a) as being unpatentable over Porter et al. in view of U. S. Patent No. 5,145,094 to Perlmutter et al. The Examiner also indicated that claims 6 and 8 would be allowable if rewritten in independent form. Before addressing the merits of these rejections, the Examiner will please note that independent claim 1 is amended to add the elements of a sleeve having a guide member and a longitudinal slot along the guide member to the outlet passage of the cap member. Additionally, the element of an ear projecting radially outwardly has been added to the valve body. Due to the amendment of claim 1 adding the elements of a sleeve, a guide member, and a longitudinal slot from claims 3 and 4, claims 3 and 4 were amended to reflect these elements being added to claim 1.

A 35 U.S.C. §102(b) rejection requires that the reference teach each and every element of the claim See *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Claim 1 as now amended has the additional elements of a longitudinal slot in the sleeve and an ear projecting radially outward from the valve body that Porter et al. does not teach, therefore the 35 U.S.C. §102(b) rejection of claim 1 has been overcome by the amendment and should be removed. The remaining 35 U.S.C. §102(b) rejections of claims 2, 3, 7, 9, and 33 are all dependent on claim 1 and should be allowable based upon the claim 1 amendment.

In establishing a *prima facie* case of obviousness under 35 U.S.C. §103 it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been lead to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *See Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. *See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434 (Fed. Cir. 1991) (The teaching or suggestion to make the claimed combination must not be based on the applicant's disclosure). For a proper rejection under 35 U.S.C. §103 all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging patentability of that claim against the prior art."). Obviousness under 35 U.S.C. §103 can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998).

Further, it should be noted that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.03. If a proposed modification to a reference by the Examiner would render the device being modified unsatisfactory for its intended purpose, then there is necessarily no suggestion or motivation to make the

proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In the 35 U.S.C. §103(a) rejection of claims 4 and 5 the examiner proposes to add the longitudinal slots and pair of stop members of Perlmutter et al. to Porter et al. to define the invention as recited in claim 4. Accordingly, the Examiner's analysis in the office action does not rise to the level of *prima facie* obviousness under 35 U.S.C. §103(a) as there is no suggestion or motivation to combine these references in the manner proposed. This is due to the functionality of Porter et al. would being lost with longitudinal slots added to the sleeve section, causing the sleeve to leak the contained product from the longitudinal slots. Upon a close examination of the sleeve sections of both Porter et al. and Perlmutter et al. shows a distinct difference in the sleeve configuration in the cap with and without longitudinal slots. When longitudinal slots are used, the sleeve must extend into the interior of the container to not allow leakage to the outside, as shown on Perlmutter et al. and in the application in Figure 5. It is not possible to add longitudinal slots to Porter et al. without altering functionality to such an extent to make Porter et al. non-functional. Therefore there would be no motivation to add the longitudinal slots of Perlmutter et al. to Porter et al. and the 35 U.S.C. §103(a) rejection as to claim 4 should be removed. As claim 5 depends from claim 4, claim 5 should be allowable also.

In accordance with the Examiner allowing claims 6 and 8 if written in independent form, claim 6 has been rewritten in independent form as new claim 34 and claim 8 has been rewritten in independent form as new claim 35.

Due to this amendment, a new filing fee calculation is provided, as follows:

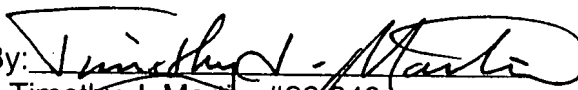
Maximum Total Claims This Amendment	Total Claims Previously Paid For	
10 -	33	=0 X \$9.00=\$0.00
Total Independent Claims per This Amendment	Maximum Independent Claims Previously Paid For	
3 -	3	=0 X \$39.00=\$00.00
Additional Filing Fee Due =\$00.00		

The Commissioner is hereby authorized to charge any deficiency in the payment of the required fees or credit any overpayment to Deposit Account No. 13-1940.

Based on the foregoing, Applicant submits that the present application is in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the Applicant at the telephone number listed below.

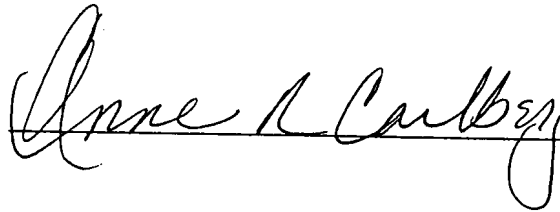
Respectfully submitted,

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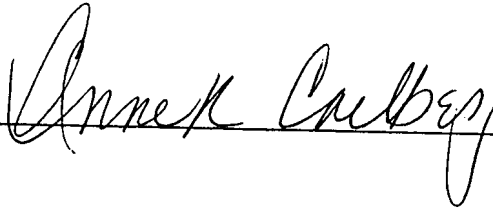
CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that the foregoing ***ONE SHEET OF CORRECTION IN RED TO FIGURES 12 AND 13 In duplicate*** is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to The Assistant Commissioner for Patents, Washington, DC 20231 on this 17th day of October, 2000.

A handwritten signature in cursive script, reading "Anne R. Carlberg", written over a horizontal line.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that the foregoing **AMENDMENT INCLUDING ONE SHEET OF CORRECTIONS IN RED TO FIGURES 12 AND 13** is being deposited with the United States Postal Service as first-class mail in an envelope addressed to The Assistant Commissioner of Patents and Trademarks Office, Washington, D.C. 20231, on this 17th day of October, 2000.


Anne K. Culbey